

Customer No.: 31561
Application No.: 10/708,366
Docket No.: 12456-US-PA

REMARKS

Present Status of the Application

The Office Action dated July 06, 2006 has rejected claims 1, 2, 3, 12-14, and 19 under 35 U.S.C. 102(b), as being anticipated by Dutcher (US-4,498,581, hereinafter "Dutcher").

The Office Action also rejected claims 4-6, 11, and 20 under 35 U.S.C. 103(a) as being unpatentable over Dutcher.

Claims 7-9 and 16-18 are rejected under 35 USC 103(a) as being unpatentable over Dutcher in view of Cuffey et al. (US-2,967,010, hereinafter "Cuffey").

Applicants respectfully traverse the rejections and amend the claims.

After entry of the foregoing amendments, claims 1-9, 11-14, 16-18, and 20 remain pending in the present application, and reconsideration of those claims is respectfully requested.

Discussion of Rejections Under 35 USC 102(b)

The Office Action has rejected claims 1, 2, 3, 12-14, and 19 under 35 U.S.C. 102(b) as being anticipated by Dutcher (US-4,498,581, hereinafter "Dutcher").

Applicants respectfully submit that independent claims 1 and 12 are allowable for at least the reason that Dutcher fails to teach or disclose each and every feature of the independent claims 1 and 12.

Amended claims 1 and 12 recite, respectively:

Customer No.: 31561
Application No.: 10/708,366
Docket No.: 12456-US-PA

Claim 1. An easily tearable film, comprising a unidirectionally tearable film with a plurality of cutting lines thereon partitioning the tearable film into a plurality of portions, wherein

an adhesive layer for sticking the easily tearable film on an object, wherein the adhesive layer is located on a surface of the unidirectionally tearable film and able to remain sticking to the object even after being torn apart and each portion of the tearable film is able to remain sticking to an object even after being torn apart;

the unidirectionally tearable film has a tearing direction; and
each cutting line has a first end point and a second end point, and has a joining point with an imaginary straight line parallel to the tearing direction that passes the first end point of a next cutting line.

Claim 12. A method for preparing an easily tearable adhesive film, comprising:

providing a unidirectionally tearable film that has a tearing direction;
forming an adhesive layer on a surface of the unidirectionally tearable film; and
forming a plurality of cutting lines on the unidirectionally tearable film dividing the tearable film into a plurality of portions, wherein each cutting line has a first end point and a second end point and has a joining point with an imaginary straight line parallel to the tearing direction that passes the first end point of a next cutting line and each portion of the tearable film is able to remain sticking to an object even after being torn apart.

Furthermore, paragraph [0031] of the present invention recites the following:

[0031] On the other hand, a flow chart of preparing an easily tearable film according to this invention is shown in FIG. 5. In step 500, a unidirectionally tearable film having a tearing direction is provided, wherein the examples of the material of the unidirectionally tearable film are described above. The step 500 may be followed by other steps, such as a step of forming an adhesive layer on the surface of the unidirectionally tearable film. **When an adhesive layer is formed on the easily tearable film, it can stick to an object after being torn apart.**

The United States Patent and Trademark Office Guidelines for Examination of Patent Applications Under the 35 U.S.C. 112, 1, 'Written Description' Requirement [Docket No. 991027288-0264-02] RIN 0651-AB10 recites the following:

Customer No.: 31561
Application No.: 10/708,366
Docket No.: 12456-US-PA

"..... Federal Circuit precedent makes clear that an **inherent disclosure must be recognized by those of ordinary skill in the art.** See, e.g., Hyatt v. Boone, 146 F.3d 1348, 1354-55, 47 USPQ2d 1128, 1132 (Fed. Cir. 1998) ('[T]he purpose of the description requirement is 'to ensure that the inventor had possession, as of the filing date of the application relied on, of the specific subject matter later claimed by him.'

* * * Thus, the written description must include all of the limitations of the interference count, or the applicant must show that any absent text is **necessarily comprehended in the description provided and would have been so understood at the time the patent application was filed.**' (emphasis added)). See also Reiffin v. Microsoft Corp., 214 F.3d 1342, 1346, 54 USPQ2d 1915, 1917 (Fed. Cir. 2000) (The 'application considered as a whole must convey to one of ordinary skill in the art, either explicitly or inherently, that [the inventor] invented the subject matter claimed * * * . See * * * Continental Can Co. USA v. Monsanto Co., 948 F.2d 1264, 1268, 20 USPQ2d 1746, 1749 (Fed. Cir. 1991) (descriptive matter may be inherently present in a specification if one skilled in the art would necessarily recognize such a disclosure))."

Based upon the above cited guidelines and the statement "[t]here is no disclosure directed to the adhesive layer coated "throughout the entire" tearable film nor does the ability of each portion of the tearable film to be adhered to an object after being

Customer No.: 31561
Application No.: 10/708,366
Docket No.: 12456-US-PA

torn apart imply that the tearable film is completely coated on a side with adhesive" in the Office Action in page 2, the following are the corresponding traversal:

1) There is clearly the presence of "inherent" disclosure due to the fact that when the teachings of "[w]hen an adhesive layer is formed on the easily tearable film, it can stick to an object after being torn apart" is taught to a person skilled in the art, that person should clearly envision of such an adhesive layer to be more likely than not to be coated throughout the entire film to be able to have the described feature of "stick to an object after being torn apart". It is well known in the art that as adhesive film is peeled off, it creates certain amount of force or stress during the tear on adjacent film material; therefore, if the adjacent material is not securely adhered by means of thorough adhesive coverage, it is very likely to be delaminated as well during tearing. In essence, since a partial coverage with the adhesive layer will result in delamination, the tearable film may not be able to stick to an object after being torn apart.

2) Regarding the alleged argument in the Office Action on page recited as the following: "... the film would typically have adhesive coated over only a portion of the film, namely as a "Post-it" product; see page 2, lines 8-16", Page 2, lines 8-16 in the disclosure of the instant application is clearly found in the "Description of the Related Art" section. Therefore, it is clearly meant as a discussion of conventional technology and methods, and should be not be misunderstood or misinterpreted as anything relating to the teaching of the various embodiments or methods of the instant application. Thus, whether

Customer No.: 31561
Application No.: 10/708,366
Docket No.: 12456-US-PA

or not the tearable film described in page 2, lines 8-16 is completely coated on one side is indeed irrelevant in the current discussion.

3) The fact that the element "adhesive layer" in the instant application is clearly a type of layer, which implies having pertinence to the entire layer and having no specific structural limitation on the shape; on the other hand, "adhesive strip" contains clearly the inherent limiting structural feature of the shape for "strip". As an analogy for comparison, a typical "metal sheet" is not equivalent to a typical "metal strip"; in fact, based upon the actual shape of a "metal sheet", it is quite conceivable to have a plurality of "metal strips" for making up one "metal sheet", as would be reasonably interpreted by a person skilled in the art.

4) Based upon the explicit and inherent teachings of the "adhesive layer" formed on the surface of the easily tearable film in paragraph [0031] in the present invention, especially with respect to the part of "[w]hen an adhesive layer is formed on the easily tearable film, it can stick to an object after being torn apart", it can be understood by a person skilled in the art that the above "adhesive layer" is inherently defined in claims 1 and 12 to be coated throughout the entire film to be able to then have the described feature of "stick to an object after being torn apart". As a result, each portion of the tearable film is able to stick to the object after being torn apart. On the other hand, Dutcher teaches the adhesive is only partially coated in limited regions (the inner top wall panel 18) as is shown in FIG. 1 in the form of "adhesive strips 28, 30", the remaining film 64 will not be able to remain sticking to an object after being torn apart IF when the

Customer No.: 31561
Application No.: 10/708,366
Docket No.: 12456-US-PA

remaining film included only parts that DO NOT have adhesive strips on them since Dutcher clearly DOES NOT teach explicitly, inherently, or implicitly of coating the entire film with an "adhesive layer". In other words, a remaining film (due to weight by gravity) will certainly not remain sticking to an object when all or almost all of the portion of the film that do indeed contain the adhesive are completely removed. Accordingly, Dutcher at least fails to teach each portion of the tearable film is able to remain sticking to an object after being torn apart.

The amended portions in claims 1 and 12 are fully supported in the disclosure as previously discussed; therefore, no new matter has been added.

Applicants submit that amended claims 1 and 12 patently define over Dutcher for at least the reason that Dutcher fails to disclose at least the features and limitations emphasized above. As a result, amended claims 1 and 12 should be allowed.

Discussion of Rejections Under 35 USC 103(a)

The Office Action has rejected claims 4-6, 11, and 20 under 35 U.S.C. 103(a) as being unpatentable over Dutcher. Claims 7-9 and 16-18 are rejected under 35 USC 103(a) as being unpatentable over Dutcher in view of Cuffey et al.

In regards to rejections to claims 4-6, 11, and 20, the "adhesive layer.....and

Customer No.: 31561
Application No.: 10/708,366
Docket No.: 12456-US-PA

each portion of the tearable film is able to remain sticking to an object even after being torn apart" in claims 1 and 12 as fully discussed in the previous discussion of rejections under 35 USC 102(b) is also clearly patentable over Dutcher in rejections under 35 USC 103(a). Furthermore, the following traversal below is also applicable:

MPEP 2143.01 recites the following: "If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims prima facie obvious. In re Ratti, 270 F.2d 810, 123 USPQ 349 (CCPA 1959)." The modification of a "adhesive strip" to become an "adhesive layer" to be coated on the entire surfaces of the carton wall panels would be certainly deemed to change the principle of operation of the "adhesive strip" of Dutcher. The original principle of operation of the "adhesive strip" in Dutcher is for the adherence of the top wall panels 18 and 40 together. On the other hand, the principle of operation for the "adhesive layer" in claims 1 and 12 of the present invention is "so that the easily tearable film 100 can stick to an object after it is torn" (as found in paragraph [0027] of the present invention).

Furthermore, MPEP 2144.08 recites the following: "... In re Bell, 991 F.2d 781, 783, 26 USPQ2d 1529, 1531 (Fed. Cir. 1993) ("The PTO bears the burden of establishing a case of prima facie obviousness.")" Indeed, the present application demonstrates nonobviousness over Dutcher in view of Cuffey.

Based on the above traversal, the teachings of Dutcher are not sufficient to render the claims prima facie obvious, and the rejections to claims 4-6, 11, and 20 should be

Customer No.: 31561
Application No.: 10/708,366
Docket No.: 12456-US-PA

overcomed based on the patentability of "adhesive layer and able to remain sticking to an object even after being torn apart" in independent claims 1 and 12. Claims 4-6, 11, and 20, which depend from claims 1 and 12 respectively, are also patentable over Dutcher, at least because of their dependency from an allowable base claim.

In regards to the rejections to claims 7-9 and 16-18, the patentable claim limitations "adhesive layer.... and each portion of the tearable film is able to remain sticking to an object even after being torn apart" in amended claims 1 and 12 as fully discussed in the previous discussion of rejections under 35 USC 102(b) are also clearly patentable over Dutcher in view of Cuffey et al. (US-2,967,010, hereinafter "Cuffey") in rejections under 35 USC 103(a). Neither Dutcher nor Cuffey teaches of the "adhesive layer and each portion of the tearable film is able to remain sticking to an object even after being torn apart" found in claims 1 and 12 of the present invention. Claims 7-9 and 16-18, which depend from claims 1 and 12 respectively, are also patentable over Dutcher in view of Cuffey, at least because of their dependency from an allowable base claim.

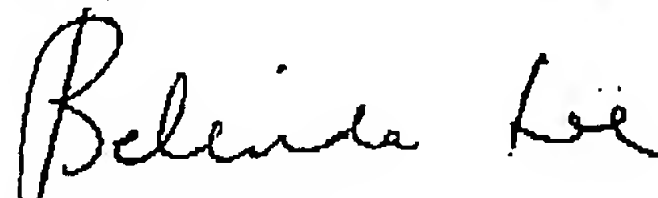
Customer No.: 31561
Application No.: 10/708,366
Docket No.: 12456-US-PA

CONCLUSION

For at least the foregoing reasons, it is believed that the pending claims 1-9, 11-14, 16-18, and 20 are in proper condition for allowance. If the Examiner believes that a telephone conference would expedite the examination of the above-identified patent application, the Examiner is invited to call the undersigned.

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Respectfully submitted,


Belinda Lee

Registration No.: 46,863

Jianq Chyun Intellectual Property Office
7th Floor-1, No. 100
Roosevelt Road, Section 2
Taipei, 100
Taiwan
Tel: 011-886-2-2369-2800
Fax: 011-886-2-2369-7233
Email: belinda@jciigroup.com.tw
Usa@jciigroup.com.tw